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Attorneys for Plaintiffs

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN FRANCISCO DIVISION

UNILOC 2017 LLC and UNILOC)	Case No.: 3:18-cv-03432-JST
LICENSING USA LLC,)	
)	PLAINTIFFS' NOTICE OF MOTION AND
Plaintiffs,)	MOTION TO DISMISS WITHOUT
)	PREJUDICE
v.)	
)	Hearing Date: January 10, 2019
BOX, INC.,)	Time: 2:00 p.m
)	Location: Courtroom 9
Defendant.)	Judge: Honorable Jon S. Tigar

On January 10, 2019 at 2:00 p.m. in Courtroom 9 of the United States District Courthouse, 450 Golden Gate Avenue, San Francisco, California, plaintiffs will present this motion before the Honorable Jon S. Tigar.

Plaintiffs move to dismiss this action under rule 41(a)(2), without prejudice.

This action was filed on June 8, 2018, naming Uniloc Luxembourg, S.A. ("Uniloc Luxembourg") as the owner of the patent in suit, and Uniloc USA Inc. ("Uniloc USA") as an exclusive licensee. Dkt. No. 1. Counsel who drafted the Complaint was unaware that on May 3,

1 2018 Uniloc Luxembourg had assigned the patent to Uniloc 2017 LLC (“Uniloc 2017”).¹ Foster
2 Decl., ¶4.

3 After learning of these transactions, on September 5, 2018, counsel added Uniloc 2017
4 LLC and Uniloc Licensing as plaintiffs, and dropped Uniloc Luxembourg. Dkt. No. 18. On
5 November 1, 2018, Uniloc USA was dropped. Dkt. No. 28. On November 15, 2018, defendant
6 Box, Inc. answered the Second Amended Complaint. Dkt. No. 33.

7 A defendant in an action in a different United States District Court has argued a License
8 Agreement between Uniloc 2017 and Uniloc USA, similar to the May 3, 2018 agreement with
9 Uniloc Licensing, divided the rights in the patents owned by Uniloc 2017 in such a way that
10 neither Uniloc 2017 nor Uniloc USA had standing to sue, and thus that court lacked subject matter
11 jurisdiction. Foster Decl., ¶6. Plaintiffs disagree with that argument.

12 But to remove that issue from this action (and other actions in which Uniloc Licensing was
13 a plaintiff) on November 16, 2018, Uniloc 2017 and Uniloc Licensing terminated the License
14 Agreement, consolidating all rights in the patent in suit to Uniloc 2017. *Id.*, ¶7. Then, to resolve
15 any question as to this Court’s having subject matter jurisdiction over the controversy, Uniloc 2017
16 refiled this action on November 20, 2018, as 3:18-cv-07038-TSH, naming only Uniloc 2017 as a
17 plaintiff.

18 Plaintiffs therefore request this Court dismiss this (previously filed) action without
19 prejudice, to allow Uniloc 2017 (and this defendant) to continue to litigate the same issues in the
20 newly filed action.

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27 ¹ At the same time, Uniloc Licensing USA LLC (“Uniloc Licensing”) replaced Uniloc USA as
28 licensee.

1 Dated: November 28, 2018

Respectfully submitted,

2 /s/ Aaron S. Jacobs

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